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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,789	07/14/2003	Kazuto Hirokawa	2003-0960A	4090

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EXAMINER

SHAKERI, HADI

ART UNIT PAPER NUMBER

3723

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

03

Office Action Summary	Application No.	Applicant(s)	
	10/617,789	HIROKAWA ET AL.	
	Examiner	Art Unit	
	Hadi Shakeri	3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of species of Figs. 1-5, in the reply filed on 09/17/04 is acknowledged.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "switching device" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
3. The drawings, e.g., Figs. 2, 4, 8, 9... are objected to because reference character defining the chamber, i.e., (68) is pointing to an end of the pad (18).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, "a switching device" for switching between the passages as recited, renders the claim indefinite. Specification as originally filed on page 24, lines 1-5, define the "switching device" to be formed by control valves V1 and V2, but it is unclear, to the Examiner, whether the "device" also includes valves (56), (57) and controller (28) or not, and since drawings, e.g., Fig. 4, does not show the device, the scope is not ascertainable. It appears a switching "means" is being claimed.

Further regarding claim 9, the use of the term "ejection" as recited in line 5, is inappropriate. "ejection" as defined by specification, e.g., page line 2, seems to indicate, "high flow rate", Applicant may wish to amend the claim to place it in better form.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

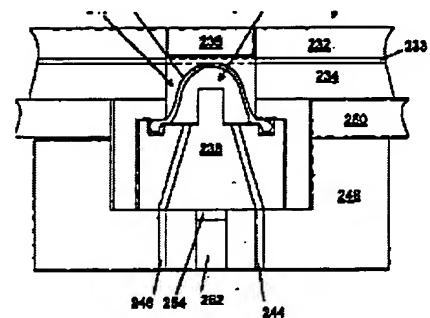
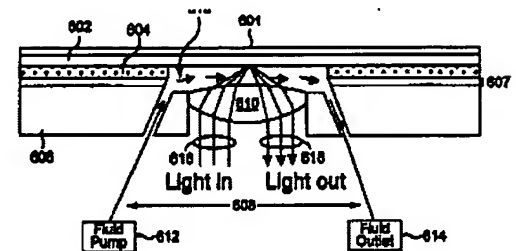
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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by either one of Lehman et al. (6,707,540), and Lehman et al. (US Pub '139).

Either one of the above references discloses all of the limitations of claim 1, i.e., a substrate polishing apparatus comprising a polishing table against which a substrate is pressed, a light-emitting and light-receiving device to emit measurement light from said polishing table to said substrate and to receive reflected light from said substrate for measuring a film on said substrate, a fluid supply passage for supplying a liquid for measurement to a fluid chamber provided at a light-emitting and light-receiving position of said polishing table, said measurement light and said reflected light passing through said fluid for measurement, and fluid supply control device for controlling supply of said fluid for measurement to said liquid chamber.



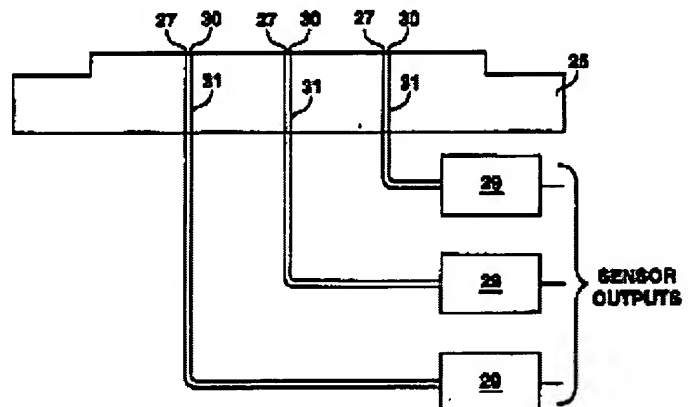
Regarding claims 2-8, prior art (US Patents '540, and US Pub '139) meets the limitations, it is noted that in an apparatus claim, the intended use and/or functional language not resulting in a structural difference are not accorded patentable weight, since the apparatus as disclosed is capable of performing the functions, i.e., with respect to the above claims, prior art discloses control device for controlling the supply and discharge of fluid (US Patents '540, 14:10-15; and US Pub '139, paragraph 128), as to how, or when the control activates and/or

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deactivates the supply and/or discharge does not further limit the apparatus, since the apparatus is capable of performing the functions, and meets the elements as recited, i.e., supply control device (claims 1-4); discharge control device, (pumps) claims 5-8.

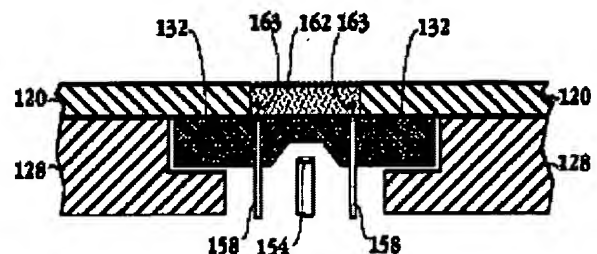
9. Claim 9 (as best understood) is rejected under 35 U.S.C. 102(b) as being anticipated by Pant et al. (5,762,536).

Pant et al. discloses all of the limitations of claim 9, as best understood, i.e., polishing apparatus comprising a polishing table (25) having polishing surface (12) against which a substrate is pressed, light emitting and light receiving devices (optical sensors 29, e.g., 05:57) and first and second passages (31) for introducing fluid through which light passes (e.g., 07:1-11), and a switching "device" for switching between the passages, i.e., (29) (35).



10. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Boyd et al. (6,599,765).

Boyd et al. discloses all of the limitations of claim 10, i.e., polishing apparatus comprising a polishing table having polishing surface against which a substrate is pressed and a passage (134) to supply a fluid to said polishing surface on said polishing table, wherein said passage includes at least two passages (158), note the explanation above regarding narrative and/or functional language, i.e., each passage may supply high or low flow rate.



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Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-8 are provisionally rejected under the judicially created doctrine of double patenting over claim 9 of copending Application No. 10/854,250. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is anticipated by claim 9 of the copending application, i.e., valve regulating the supply to the hole, which inherently controls the discharge.

13. Claim 10 is provisionally rejected under the judicially created doctrine of double patenting over claim 7 of copending Application No. 10/617,794. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is anticipated by claim 7 of the copending application, i.e., a supply and an auxiliary supply passage.

Conclusion

14. Prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Nikoonahad et al. is cited to show related inventions.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is (571) 272-4495. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Hadi Shakeri', with a stylized flourish at the end.

Hadi Shakeri
Primary Examiner
Art Unit 3723
November 27, 2004